

REMARKS

This paper responds to the final Office Action of June 9, 2009. Prior to entry of this paper, claims 1-32 were pending in this application. No claims are amended, canceled, or added by way of this paper. Accordingly, claims 1-32 remain pending.

The instant Office Action rejected pending claims 1-32. More specifically, the status of the application in light of this Office Action is as follows: claims 1-22 and 27-32 stand rejected under 35 U.S.C. § 103(a) over a combination of U.S. Patent Pub. No. 2001/0026512 ("Nishimura") and alleged "TW Publication 092133484" ("Chiu-TW"), and claims 23-26 were rejected under 35 U.S.C. § 103(a) over a combination of Nishimura, Chiu, and U.S. Patent No. 5,053,965 ("Fujimura").

Applicants respectfully traverse these rejections.

In the preceding Office Action of March 16, 2009, the Office issued rejections substantively identical to those of the instant Office Action. However, the rejections of the preceding Office Action relied upon U.S. Patent Pub. No. 2005/0117222 ("Chiu-US") instead of now relied upon Chiu-TW.

On May 14, 2009, applicants traversed the prior rejections on the basis that Chiu-US is not prior art to the instant application and noted that the Taiwanese application, from which Chiu-US claims priority, is not prior art to the instant application at least because the Taiwanese application does not qualify as prior art under 35 U.S.C. § 102(e). Applicants also pointed out the instant application's claim of priority to a provisional application of Jan. 28, 2003, and disagreed with the Office's characterization of Chiu-US. (Response of May 14, 2009, pgs. 12-13.)

The Office now points to Chiu-TW, as allegedly translated by Chiu-US, as teaching the "fixed scaling" of each of applicants' independent claims. (Office Action, pgs. 2-3 and 8.) The Office admits that "fixed scaling" is missing from Nishimura and does not point to Fujimura as teaching "fixed scaling." (Office Action, pgs. 3 and 8.)

The instant Office Action also alleges that (1) "the foreign publication of Chiu was issued on 1-12-2004" and "beats the filing date of the current application," (2) applicants' provisional application was not originally filed in English, and (3) applicants' provisional application does not support applicants' "fixed scaling factors" or use of "reflected light signals instead of previously sampled and held signals."

With respect to the allegation that a foreign publication of Chiu-TW issued on Jan. 12, 2004 and thus "beats the filing date of the current application," applicants respectfully disagree because Chiu-TW is not a prior art publication. Applicants also respectfully submit that Chiu-TW should not have been cited because MPEP § 901.05 states that "[i]n general, a foreign patent, the contents of its application, or segments of its content should not be cited as a reference until its date of patenting of publication can be confirmed by an examiner's review of a copy of the document." (Emphasis added.)

Here, Chiu-TW is a certified copy of TW Application No. 092133484. (See, cover page of Chiu-TW which states "[t]his is to certify that annexed is a true copy from the records of this office of the application as originally filed... .") Based on applicants' representative's review of Chiu-TW and the file history of U.S. Patent Application No. 10/819,140 (from which Chiu-US stems), it appears that Chiu-TW was filed with the Office on Apr. 7, 2004, as a certified copy of a foreign priority application. (See, e.g., Public Pair.) However, the undersigned has seen no indication that Chiu-TW was published or otherwise made publicly available on Jan. 12, 2004, or at any time before the June 2, 2005, publication of Chiu-US. In fact, applicants' Taiwanese representatives have advised the undersigned that Chiu-TW is not a publication, but was provided to Chiu-TW's applicant, on request, e.g., to facilitate foreign (U.S.) filing. Applicants' Taiwanese representatives have also advised that TW Application No. 092133484 is not publicly accessible from Taiwanese Patent Office website. Applicants also note that the Office has failed to provide any indication, as required by MPEP 706.02(II), that Chiu-US is a translation of Chiu-TW. For at least these reasons, applicants respectfully

submit that Chiu-TW is not effective as prior art to the instant application and respectfully request that the 35 U.S.C. § 103(a) rejections be withdrawn.

With respect to the allegation that applicants' provisional application was not filed in English, applicants respectfully submit that the instant application is entitled to the provisional application's priority date of Jan. 28, 2003, irrespective of the language of the provisional application. (See, e.g., MPEP § 201.11(VI).) Specifically, applicants perfected a claim of priority to the provisional application under 35 U.S.C. § 119(e) by indicating the claim of priority in the preliminary amendment filed with the instant application on Jan. 27, 2004, and filing the certified translation of the provisional application on June 8, 2007. Accordingly, under 35 U.S.C. § 119, applicants are entitled to a priority date of Jan. 28, 2003, which is before Chiu-TW's filing date of Nov. 28, 2003, and is before Chiu-TW's alleged "foreign publication" date of Jan. 12, 2004.

With respect to the allegation that applicants' provisional application does not support applicants' "fixed scaling factors" or use of "reflected light signals instead of previously sampled and held signals," applicants also respectfully disagree. Applicants respectfully submit that the "fixed scaling factors" are supported at least by fixed resistor values R1-R3 of the circuit shown at the bottom of page 1 of the provisional application, by fixed resistor values R1-R4 of the circuits shown at the bottom of page 2 of the provisional application, and by the formulas accompanying these aforementioned circuits. Applicants respectfully submit that the use of "reflected light signals instead of previously sampled and held signals," are supported at least by reflected light signals A, B, C, and D of the provisional application and the statement "[t]hus better signal quality is obtained without using the sample and hold device" on page 1 of the provisional application. Accordingly, applicants respectfully submit that pending claims are fully supported by the provisional application and respectfully request that the 35 U.S.C. § 103(a) rejections be withdrawn for at least these additional reasons.

Finally, applicants continue to respectfully disagree with the Office's characterization of both Chiu-US and Chiu-TW and submit that there is no reason to combine either Chiu-US or Chiu-TW with Nishmura. The Office appears to point to the "fixed fine scale" of Chiu-US's paragraph [0038] as corresponding to applicants' "fixed scaling factors." (Office Action, pgs 3 and 8.) However, Chiu-US (and presumably Chiu-TW) is directed to an entirely different field of endeavor, namely, to the manufacture of optical grating elements that can be employed to detect angles, speeds, or positions. (See, e.g., Chiu-US, Abstract and paragraphs [0004]-[0005].) In this context, the phrase "scale" of Chiu-US's paragraph [0038] refers to the angular pitch of the light and dark areas of the patterns shown by figures 5A and 5B of Chiu-US, rather than the signal scaling of applicants' technology. Accordingly, one of ordinary skill in the relevant art would not seek to combine either Chiu-US or Chiu-TW with Nishmura to arrive at applicants' technology. Applicants respectfully request that the 35 U.S.C. § 103(a) rejections be withdrawn for at least these additional reasons.

Each of the remaining dependent claims depends from an aforescussed independent claim. Accordingly, each of the remaining dependent claims is allowable based at least on its dependence on one of the independent claims.

Conclusion

In view of the foregoing, the pending claims are patentable over the applied art and comply with the requirements of 35 U.S.C. § 112. The applicants accordingly request reconsideration of the application and a mailing of a Notice of Allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to contact Davin Chin at (206) 359-8000.

Respectfully submitted,

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